

RESPONSE UNDER 37 C.F.R. 1.116
EXPEDITED PROCEDURE
EXAMINING GROUP 2179
Due Date: July 10, 2009

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Christopher Vienneau et al.	Examiner:	Nicholas Augustine
Serial No.:	10/619,758	Group Art Unit:	2179
Filed:	July 15, 2003	Docket:	G&C 30566.335-US-01
Title:	PROCESSING IMAGE DATA		

CERTIFICATE OF MAILING OR TRANSMISSION UNDER 37 CFR 1.8

I hereby certify that this correspondence is being filed electronically via EFS- web to the U.S. Patent and Trademark Office on May 5, 2009.

By: /Katie Yazgolian/
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PETITION UNDER 37 C.F.R. §1.181

MAIL STOP AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This Petition is being submitted in accordance with M.P.E.P. §1002.02(c) to invoke the supervisory authority of the Commissioner under 37 C.F.R. §1.181 involving an ex parte action in the above-identified patent application that is not subject to appeal.

Applicants' attorney requests a review of the sufficiency of the Declaration under 37 C.F.R. §1.132 submitted by the assignee in the above-identified patent application. In a final Office Action dated April 10, 2009, the Examiner stated that the Declaration was insufficient to overcome the rejection of the claims.

In the final Office Action, the Examiner asserts the following:

“Applicant’s ‘unequivocal statement’ is insufficient to establish inventorship because it is unclear as to which disclosures were obtained from the declared inventor. There is ambiguity in the record created by the affidavit as the reference used for the 102(a) rejection was shown as invented by Trinh and Gaudette and the present application was invented by Vienneau and Di Lelle but the only common feature is the

assignee. Further, there are several pages of disclosure attributed to Trinh and Gaudette and it is unclear as to which disclosure from the statement “those disclosures” actually originated by the inventors of the present application. See Support MPEP 716.10. It states that the claimed subject matter solved a problem that was long standing in the art. However, there is no showing that others of ordinary skill in the art were working on the problem and if so, for how long. In addition, there is no evidence that if persons skilled in the art who were presumably working on the problem knew of the teachings of the above cited references; they would still be unable to solve the problem. See MPEP §716.04. In such the affidavit does not show any evidence other than a statement showing inventorship. To remove ambiguity in the record the Examiner request that the reference of Trinh be updated to clearly reflect the correct inventorship and at least one piece of evidence could be submitted to lead the Examiner to a reasonable conclusion that the applicant is the inventor of the subject matter disclosed in the referenced application used in the 102(a) rejection.”

Applicants’ attorney disagrees.

Firstly, the summary of the declarations by the Examiner is incorrect and in complete disregard for the express language of the declarations. The declarations provide:

“2. U.S. Patent Publication No. 2002/0051005A1, published May 2, 2002, by Stephane Trinh et. al., entitled “Processing Pipeline Responsive to Input and Output Frame Rates,” (now U.S. Patent No. 6,924,821, issued August 2, 2005) (hereinafter “Trinh”) was cited by the Examiner in several Office Actions including the Office Action dated October 17, 2008 during the examination of the above-identified patent application.

3. To the extent Trinh discloses the subject matter claimed in the above-identified patent application, those disclosures originated with or were obtained from me and my co-inventor, as inventors of the above-identified patent application.

5. The other named inventors of Trinh, Stephane Trinh and Michel Gaudette are not inventors of the subject matter claimed in the above-identified patent application. Only myself, and Christopher Vienneau are inventors of the subject matter claimed in the above-identified patent application, and thus are the only inventors named on the above-identified patent application.”

As can clearly be seen, contrary to that asserted by the Examiner, the declarations do not even mention that the claimed subject matter solved a problem that was long standing in the art. Accordingly, the Examiner’s requirement for new evidence relating to such an unsolved problem, is without foundation, and clearly in error.

In addition to the above, Applicants note that the Declarations were not intended to show a long standing need but were intended to show attribution. M.P.E.P. §716.10, which is entitled “Attribution,” states that:

“An uncontradicted unequivocal statement from the applicant regarding the subject matter disclosed in an article or patent will be accepted as establishing inventorship. In re DeBaun, 687 F.2d 459, 463, 214 USPQ 933, 936 (CCPA 1982).”

The Declaration makes such an uncontradicted unequivocal statement.

The Examiner asserts that there is ambiguity because there are several pages of disclosure attributed to Trinh and it is unclear as to which disclosure actually originated by the inventors of the present application. Again, the declarations are unequivocal in their assertions and state that to the extent Trinh discloses the subject matter claimed in the present application, such disclosures were obtained from the inventors of the present application. There is no ambiguity in such a statement whatsoever. The declarations are clear in that to the extent the subject matter claimed in the present application is described in Trinh, such subject matter was invented by Vienneau and DiLelle. Based on the MPEP section cited above, the Examiner is required to accept the declaration as establishing inventorship. The Examiner has presented no evidence that contradicts or gives rise to a challenge to such an attribution as set forth in the declaration.

Further, Applicants submit that the “several pages” the Examiner is referring to are irrelevant. What is relevant is what is claimed in the present invention. Again, to the extent the subject matter is described in Trinh but claimed in the present application, the declarations are unambiguous in that such attribution belongs to Vienneau and Di Lelle.

The Applicants note that consistent with the Examiner’s acknowledgement, the references are both owned by a common assignee. Thus, no further evidence of ownership is required in the application.

In addition, the Examiner’s request to update Trinh – a related application that is not currently under examination is improper and without any foundation in the statutes, regulations, or MPEP. In this regard, Applicants note that Trinh is not currently under examination but has issued as US Patent No. 6,924,821. Further, no evidence is necessary beyond the declarations that have been submitted. It is clear in the MPEP, that the declarations submitted are sufficient and must be accepted by the Examiner as establishing inventorship.

In light of the above, it is respectfully submitted that it was erroneous, as a matter of law, for the Examiner to state that the Declaration under 37 C.F.R. §1.132 was insufficient to eliminate the Trinh reference as a prior art reference.

This Petition is being submitted electronically, and thus Applicants request that any required Petition fees be charged to the Deposit Account No. 50-0494 of Gates & Cooper LLP. Any other fees should be charged to Deposit Account No. 50-0494 as well.

Respectfully submitted,

GATES & COOPER LLP
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G&C 30566.335-US-01

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